

Application Serial No.: 10/763,884
Amendment and Response to March 30, 2007 Non-Final Office Action

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REMARKS

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Claims 1 – 14, 17, and 18 remain in the application. Claim 17 is currently amended; claims 1 and 18 were previously presented; claims 15 and 16 have been canceled; and claims 2 – 14 remain unchanged from the original versions thereof. Claims 1, 17 and 18 are the independent claims herein.

No new matter has been added as a result of the amendments submitted herewith.

Reconsideration and further examination of the application are respectfully requested.

Claim Rejections – 35 USC § 101

Claim 17 was rejected under 35 USC 101 as being directed to non-patentable subject matter. This rejection is traversed.

Applicant respectfully submits that claim 17 is directed to a computer readable medium having computer readable instructions stored on which, when executed by a computer, cause the computer to execute the recited processes of the claim. Further, the claimed processes or steps are directed to a practical application that produces a useful, concrete, and tangible result. The useful, concrete, and tangible result includes sending the claimed instant message and first voice mail message to the internet message address of the recipient, per the claimed instructions stored on the medium. Clearly, the sending of the instant message and first voice mail message to the internet message address of the recipient according to the claimed instructions stored on the medium results in a useful and repeatable real-world result.

Claims 1 – 14 and 18 were rejected under 35 USC 101 for being an article of manufacture "running the method claims." This rejection, while traversed, is not fully understood since claims 1 – 14 are directed to a method and claim 18 is directed to an

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apparatus including a processor, a communication port, and a storage device. Clearly, the claimed apparatus including a processor, a communication port, and a storage device is patentable subject matter under 35 USC 101. Regarding the method of claim 1, Applicant claims a method that provides concrete, tangible real-world results. For instance, the claimed method includes sending the first instant message and the first voice mail message to the address of the recipient. The operation of sending the first instant message and the first voice mail message to the address of the recipient is repeatable, tangible, and concrete.

Accordingly, Applicant respectfully submits that claims 1 – 14, 17, and 18 all include patentable subject matter under 35 USC 101, and further respectfully requests the reconsideration and withdrawal of the rejection thereof under 35 USC 101.

Claim Rejections – 35 USC § 103

Claims 1, 4 – 6, 10 – 15, 17, and 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Adamczyk, U.S. Publication No. 2004/0151284 in view of Ward et al., U.S. Publication No. 2004/0151284 A1 (hereinafter, Ward). This rejection is respectfully traversed.

The pending claims relate to a method (claim 1), a medium (claim 17), and an apparatus (claim 18) for providing a voicemail message to a recipient of the voicemail message including, receiving a first voice mail message, the first voice mail message being associated with a recipient of the voicemail message, converting the first voice mail message to a first instant message, determining an instant message address associated with the recipient, and sending the first instant message and the first voice mail message to the address of the recipient. Thus, it is clear that the first instant message and the first voice mail message are both sent to the address of the recipient

The Office Action cites and relies upon Adamczyk for disclosing all aspects of claims 1, 15, and 17 except for sending the first instant message and the first voicemail message to the address of the recipient. The Office Action further cites and relies upon

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Ward for allegedly disclosing sending the first instant message and the first voicemail message to the recipient address. However, Applicant respectfully submits that the combination of Adamczyk and Ward fails to disclose or suggest (at least) the claimed sending of the first instant message and the first voice mail message to the address of the recipient.

In contrast to Applicant's pending claims, Ward discloses a system and method for instant voice messaging. According to Ward, a user may record a short voice message (e.g., 30 seconds) and send that recorded voice message to a recipient. (See Ward, paragraph 0023) Thus, the "instant message" referred to in Ward is an actuality an instant voice message.

Referring the cited and relied upon Ward, Applicant notes that paragraph 0032 states,

[0032] To receive the instant message automatically, or without user intervention, i.e. in "Auto" mode, the instant message server 18b first sends a message to the telephone set 20b to connect the speaker to the IP audio stream (for example, IP stream 19b illustrated in FIG. 1) if the recipient user is not on another active call. The instant message server 18b sends the IP audio stream to the telephone set 20b, and the instant message is played over the handsfree speaker for the user to hear. If the recipient, i.e. telephone 20b, is on another call, then the instant message server 18b sends a message to the call server 14 to set up a conference bridge (indicated by reference 21 in FIG. 1) such that only the recipient at telephone set 20b can hear all parties in the conference, i.e. the party on the original call and the instant voice message call. The other parties in conference only hear each other, and not the instant voice message. The instant message server 18b, then sends the IP audio stream to the conference bridge 21 so that User B at telephone set 20b hears the instant message in addition to the existing conversation. (emphasis added)

Thus, it is clear that Ward discloses a system and method that relates to an instant voice message. The Ward disclosed "instant messages" are in fact instant voice messages since conventional text-based instant messages cannot be streamed as an IP audio stream. Further, Ward does not disclose any translation of a text-based instant message to a voice-based instant voice message. This is true, since Ward specifically and exclusively deals with instant voice messages.

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Applicant notes that while Ward refers to the disclosed instant voice messages as both an "instant voice message" and also simply as an "instant message", it is clear from the context and clear, explicit disclosure of Ward that the disclosed system and method explicitly relates to instant voice messages that are recorded, forwarded, played, and otherwise processed by the method and system therein.

Applicant reiterates that Ward fails to disclose the claimed sending of an instant message and a voicemail.

Furthermore, combining the disclosures of Adamczyk and Ward, as done in the Office Action does not overcome or correct the deficiencies of Ward. The Adamczyk/Ward combination appears to be contradictory and not compatible with the plain teachings of the references. For instance, Adamczyk explicitly discloses a user having the option of leaving a conventional voice mail message or to transmit an instant message to another subscriber. (See Adamczyk, paragraph 0066, In. 13 15) On the other hand, Ward merely discloses sending an instant voice message to a recipient. (See Ward, Abstract) Thus, Adamczyk appears to teach away from a method, system, apparatus, or the modification of Adamczyk that would provide sending both the voicemail and an instant message to a recipient. That is, one skilled in the art would not be motivated to modify Adamczyk with the disclosure of Ward as alleged by the Office Action since Adamczyk specifically teaches not sending both the voicemail message and text message and Ward discloses only sending a speech-based instant voice message.

Accordingly, Applicant respectfully requests the reconsideration and withdrawal of the rejection of claims 1, 17, and 18 under 35 USC 103(a). Claims 4 – 6 and 10 – 14 depend from claim 1. For at least the same reasons provided hereinabove for the patentability of claim 1, Applicant respectfully submits that claims 4 – 6 and 10 – 14 are also patentable over Adamczyk and Ward under 35 USC 103(a), and requests the reconsideration and withdrawal of the rejection thereto.

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Claims 2 and 3 were rejected as being unpatentable over Adamczyk in view of Ward as applied to claim(s) 1 above, and further in view of Hanson, et al., U.S. Patent No. 6,697,474 B1 (hereinafter, Hanson). This rejection is traversed.

Inasmuch as Ward fails to disclose, or even suggest, that for which it is cited and relied upon, the combination of Adamczyk and Ward with the asserted Hanson is insufficient to support the rejection of claims 2 and 3 under 35 USC 103(a).

Accordingly, Applicant respectfully requests the reconsideration and withdrawal of the rejection of claims 2 and 3 under 35 USC 103(a).

Claims 7 and 8 were rejected as being unpatentable over Adamczyk in view of Ward as applied to claim(s) 1 above, and further in view of Agraharam et al., U.S. Patent No. 6,654,448 B1 (hereinafter, Agraharam). This rejection is traversed.

Again, Ward fails to disclose or even suggest that for which it is cited and relied upon for disclosing. The combination of Adamczyk and Ward with the asserted Agraharam is insufficient to support the rejection of claims 7 and 8 under 35 USC 103(a).

Accordingly, Applicant respectfully requests the reconsideration and withdrawal of the rejection of claims 7 and 8 under 35 USC 103(a).

Claim 9 was rejected as being unpatentable over Adamczyk in view of Ward as applied to claim(s) 1 above, and further in view of Groner, U.S. Patent No. 6,507,643 B1 (hereinafter, Groner). This rejection is traversed.

Applicant reiterates that Ward fails to disclose or even suggest that for which it is cited and relied upon for disclosing. The combination of Adamczyk and Ward with the asserted Groner is insufficient to support the rejection of claim 9 under 35 USC 103(a).

Accordingly, Applicant respectfully requests the reconsideration and withdrawal of the rejection of claim 9 under 35 USC 103(a).

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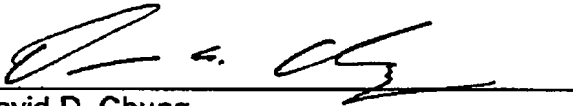
CONCLUSION

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Accordingly, Applicant respectfully requests allowance of the pending claims. If any issues remain, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is kindly invited to contact the undersigned via telephone (408) 492-5336.

Respectfully submitted,

2 July 2007
Date


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